

pivotal movement of second arm (4) relative to first arm (2). Actuator element (12) is released and drives staple ejector blade (10) to eject a staple through staple ejector slot (9) with a significant force, when second arm (4) reaches a second extent of its pivotal movement relative to first arm (2).

Based on the above Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections, and that he withdraw them.

Objection to the Disclosure

The specification has been objected to for failure to contain proper headings. Applicants submit that this objection has been overcome by the addition of headings as recommended by the Examiner.

Rejection under 35 U.S.C. § 112, ¶ 2

Claims 1-8 have been rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants submit that this rejection has been rendered moot since claims 1-8 have been cancelled. New claims 9-15 have been carefully revised in order to positively

set forth the subject matter which Applicants regard as the invention.

Rejections under 35 U.S.C. § 102

Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Balma '729. To the extent the Examiner may consider this rejection to be applicable to new claims 9-15, it is respectfully traversed as being based upon a reference which neither teaches nor suggests the claimed invention.

As recited in new independent claim 9, the invention is directed to a stapling machine having a first arm, and a second arm pivotally connected to the first arm. The second arm has a magazine for carrying staples, a staple ejection slot, means for biasing staples within the magazine towards the staple ejection slot, a staple ejector blade for ejecting staples through the staple ejection slot, and an actuator element for moving the staple ejector blade relative to the second arm as a result of pivotal movement between the first and second arms. The actuator element remains stationary relative to the second arm during a first extent of the pivotal movement of the second arm and is released to drive the staple ejector blade during a second extent of the pivotal movement of the second arm.

Balma '729 patent differs from the combination recited in claim 9 in several significant respects. More specifically, Balma '729 discloses a plier stapler having a first arm (5) pivotally connected to a second anvil arm (30). However, in Balma the magazine for carrying staples (2) is not carried on first arm (5), but rather is pivotally connected to arm (5) through pivot pin (4). Pressing member (6) is rigidly connected to arm (5) by a pin (61) and legs (6', 6"), which are held in position by bracket members (5') on arm (5). As stated at column 2, lines 38-43, spring (15) does not retain actuator element (47) in a first position, but rather serves to bias closure member (10) to a lowermost position relative to pressing element (6), wherein pressing element (6) is fixed with respect to arm (5). When actuator lever (40) is pivoted about pin (42), arm (5) pivots relative to arm (30) about pivot pin (4). As pressing roller (46) slides along track (47), staple ejector blade (6) moves along with arm (5) causing a staple to be ejected. Consequently, in this arrangement, if actuator lever (40) is actuated slowly the staple will be ejected slowly, and may fail to penetrate a large number of sheets of paper.

Therefore, Applicants respectfully submit that Balma does not teach the combination of features of a second arm pivotally connected to a first arm, and the second arm having mounted thereon a magazine for carrying staples, a staple

ejector blade for ejecting staples, an actuator element for moving the staple ejector blade relative to the second arm, and means for retaining the actuator element in a stationary position relative to the second arm during a first extent of the pivotal movement of the second arm, and means for releasing the actuator element for movement relative to the second arm during the second extent of pivotal movement of the second arm.

Therefore, since new independent claim 9 recites a combination of physical features which are not present in any reference, Applicants submit that new independent claim 9, and hence dependent claims 10 and 11, clearly recite a novel combination of physical features which distinguishes over any and all references under § 102.

Applicants also submit that the above recited novel combination of features in new independent claim 9, and hence in dependent claims 10 and 11, provides new and unexpected results, and provides a simpler device than prior art devices. Specifically, the retention of the actuator element in a stationary position relative to the second arm during a first extent of pivotal movement of the second arm allows for an increase in the potential energy of the actuator element without the requirement of a relatively large space for the containment of a compression spring in extended and compressed conditions. The subject stapling machine, like the prior art

stapling machine having a conventional compression spring, ejects a staple with a large force that is not dependent on the speed of actuation of the actuating lever. Furthermore, the mounting of the staple magazine, the staple ejector blade (which can be moved relative to the second arm,) and the actuator element on the second arm provides a simpler and more compact arrangement than prior art devices.

Therefore, Applicants respectfully submit that the novel combination of features recited in new independent claim 9, and hence in new dependent claims 10 and 11, is not obvious from the teaching of the prior art and should be allowed.

Rejections under 35 U.S.C. § 103

Claims 2 and 3 have been rejected under 35 U.S.C. § 103 as being unpatentable over Balma '729 in view of Olney et al. Applicants respectfully submit that Olney et al. does not teach or suggest a means for retaining an actuator element in a stationary position relative to one of two arms pivotally connected to each other, as recited in new independent claim 9 and hence new dependent claims 10 and 11. Olney et al. shows a ram (39) secured to a drive blade (41) wherein a first arming stroke of ram (39) is defined by movement of the ram (39) away from a driving station (7), with the resultant compression of springs (42, 43), and a firing stroke, when

lifting plate (32a) is disengaged from ram lifting lug (38) as a result of movement of ram lifter (32) away from ram (39).

Applicants submit that the novel combination of features recited in new independent claim 9, and hence new dependent claims 10 and 11, is unobvious and hence patentable under 35 § 103 since a simpler and more compact arrangement than taught or suggested by the prior art is allowed for by the inclusion of means for retaining the actuator element in a stationary position relative to the second arm during a first extent of pivotal movement of the second arm, as discussed above.

Indication of Allowable Subject Matter

Applicants thank the Examiner for the indication that claims 4-8 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims. New independent claim 12 has been amended in order to overcome the rejection under 35 U.S.C § 112, as with new independent claim 9, and new independent claim 12 includes all of the limitations of original claims 1, 2, and 4. Therefore, Applicants respectfully submit that new independent claim 12 and hence dependent claims 13-15 are in condition for allowance.

Conclusion

All rejections of the Examiner have been complied with, properly traversed, or rendered moot. Thus, it is respectfully urged that the application is in condition for allowance. Should the Examiner have any questions after reviewing this Amendment, he is cordially invited to call the undersigned attorney.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

MASON, FENWICK & LAWRENCE

Date: 13 Jan 94

1225 Eye Street N.W.
Suite 1000
Washington, D.C. 20005
(202) 289-1200

By: Nathaniel A. Humphries

Nathaniel A. Humphries
Registration No. 22,772

I:\PATPRO\811446.AM1